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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,365	03/28/2005	Takashi Nomura	029267.56084US	4787

23911 7590 06/20/2008  
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EXAMINER
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NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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3661

MAIL DATE	DELIVERY MODE
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06/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/529,365	<b>Applicant(s)</b> NOMURA, TAKASHI	
	<b>Examiner</b> CUONG H. NGUYEN	<b>Art Unit</b> 3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2/14/08 (the RCE).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,11,12,14-18,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-7,9,11,12,14-18,20 and 21 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/14/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

1. This Office Action is the answer to the RCE, and the IDS filed on 2/15/2008, which papers have been placed of record in the file.
2. Claims 1-7, 9, 11-12, 14-18, and 20-21 are pending in this application (claims 8, 10, 13, and 19 were canceled).

***Response***

3. Since pending claims are amended that directing to 2 different subject matters in a claimed set: i.e., a data product (i.e., a computer program imbedded in a computer-readable medium – see claim 2, lines 1-2, and a map data processing apparatus (see claim 21, line 1); they are unclear - the examiner is regret for any inconvenience this may cause.

About manner of claiming:

According to MPEP,

- I. The definition of the matter for which protection is sought shall be in terms of the technical features of the inventions (i.e., a computer-readable medium having a program, and/or a map data processing apparatus – it is unclear that if “or a map data processing apparatus” is not what claimed, it is left with only map information in a computer-readable medium; according to what claim, these claimed limitations are well-known).
- II. Whenever appropriate, claims shall contain:
- III. I. A statement indicating those technical features of the invention which are necessary for the definition of the claimed subject matter but which, in combination, are part of the prior art,

- IV. II. A characterizing portion – preceded by the words “characterized in that,” “characterized by,” “wherein the improvement comprises,” or any other words to the same effect – stating concisely the technical features which, in combination with the features stated under (I), it is desired to protect.
- V. Where the national law of the designated State does not require the manner of claiming provided for in paragraph (b), failure to use that manner of claiming shall have no effect in that State provided the manner of claiming actually used satisfies the national law of that State.

The claims must “define the matter for which protection is sought.” As to the manner of claiming, the claims must, whenever appropriate, be in two distinct parts; namely, the statement of the prior art and the statement of the features for which protection is sought (“the characterizing portion”). The physical requirements for the claims are the same as those for the description.

***Claim Rejections- 35 USC §112***

The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 21 are rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is directed to a map data processing apparatus, and it is dependent on claim 20 that directed to a computer-readable product; therefore, it is unclear.

***Election/Restrictions***

5. This application contains claims directed to the following patentably distinct species of the claimed invention:

- Group I: for example, claims 2-5, and 20-21.
- Group II: for example, claim 1.

The inventions are distinct, each from the other because of the following reasons:

Inventions group I and II are related as **combination and sub-combination**. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the sub-combination as claimed for patent-ability, and (2) that the sub-combination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the sub-combination as claimed **because sub-combination not essential to combination**,  $AB_{br}/B_{sp}$  Restriction is proper.

The claimed apparatus of group I (combination) recites “A data product readable by one of a computer or and a map data processing apparatus, comprising: map data including map-related information related to a map, wherein:

the map-related information includes a compilation of a plurality of information elements; the map-related information being updateable in units of the individual information elements at the map data processing apparatus; the map-related information includes management information used to manage the map-related information, which is also updated when the map-related information is updated in units of the individual information elements; (see claim 2)” (which is a broad sub-combination,  $B_{br}$  ( $B_{broad}$ )), and A “roads are each indicated as a link string having a plurality of continuous links, with nodes representing points on the roads and each link representing a road portion connecting two adjacent nodes; and

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the information elements each correspond to information related to a link string and the map-related information is updated in units of link strings.” which indicates that in the combination,  $AB_{br}$ , the sub-combination,  $B_{br}$ , is broadly recited and that the specific characteristics set forth in the sub-combination claim, group II, is directed to a computer-readable data product, comprising: map data including map-related information related to a map, wherein: the map-related information includes a compilation of a plurality of information elements the map-related information being updateable in units of the individual information elements at the map data processing apparatus; and the information elements each include identification information indicating whether information pertaining to the information element is valid or invalid; and the identification information of an information element that has been updated and become old is set invalid”(which is specific,  $B_{sp}$  ( $B_{specific}$ )) are not set forth in the combination claim.

Since claims to both the sub-combination and combination are presented and assumed to be patent-able, the **omission of details of the claimed sub-combination  $B_{sp}$  (group II) in the combination claim  $AB_{br}$  (group I) is evidence that the patent-ability of the combination does not rely on the details of the specific sub-combination.** The sub-combination has separate utility such as for (new application) device/system.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759 (email address: cuong.nguyen@uspto.gov). The examiner can normally be reached on 9:30 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/CUONG H. NGUYEN/  
Primary Examiner  
Art Unit 3661